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IN THE

Supreme Court of the United States

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,
Petitioner,

v.

TRIO PROCESS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION.

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October 6, 1972.

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BRIEF FOR RESPONDENT IN OPPOSITION.

A. OPINIONS BELOW.

The District Court's opinion, dated January 27, 1971, is reproduced on pages 1a-14a of petitioner's appendix.

The Court of Appeals' opinion, filed May 22, 1972, is reproduced on pages 15a-30a of petitioner's appendix, and the Opinion Sur Petition for Rehearing is on pages 31a-32a thereof.

B. JURISDICTION.

Petitioner has correctly stated the basis for jurisdiction.

C. THE QUESTIONS INVOLVED.

Petitioner's statement of the questions involved is hardly appropriate, because it intermixes hypotheses and argument with the ultimate questions. Respondent submits here a succinct counterstatement of the questions, the facts and argument being relegated to the subsequent parts of this brief:

Was the Court of Appeals correct in its holdings:

1. That respondent's patent No. 3,076,421 is valid;
2. That the alleged omissions or misrepresentations were not material;
3. That petitioner has infringed the patent; and
4. That such infringement was willful?

D. STATUTES AND REGULATIONS INVOLVED.

Petitioner has correctly cited certain sections of Title 35, U. S. Code and the pertinent rule from the Rules of Practice of the U. S. Patent Office.

E. STATEMENT OF THE CASE.

The statement of the case on pages 8-10 of the Petition is distorted and argumentative.* Respondent therefore submits the following counter-statement.

Petitioner is seeking to have the Supreme Court review the decision for plaintiff-respondent in a suit for willful infringement of respondent's Spitz Patent 3,076,421 issued February 5, 1963. That patent describes and claims a new, advantageous process for the recovery of the metal content of scrap electrical wire (generally copper, worth approximately $.50 per pound).

Spitz's patented process is an inversion of the prior technique in recovery of the copper from scrap electrical wire. Before his invention, aside from the inefficient, unsatisfactorily controlled and virtually abandoned open-field burning of scrap wire, the prevailing technique involved rapid burning at very high temperature in a stationary furnace with refractory lining. The scrap wire had to be either baled or placed in a basket, transported, injected into the intensely hot interior of the fixed refractory furnace where it was kept for a period of about one hour, and then extracted, to be followed by introducing a further charge of basketed or baled scrap wire.

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* Petitioner elected not to have the record or any portion thereof certified and transmitted. Pursuant to Rule 21, respondent has brought about the certification and transmission of the Final Pre-Trial Order and those trial record pages and exhibits which are referred to herein.

Spitz invented a process which was opposite to the prior art. He burned the wire under conditions of very limited air intake and used air cooling, resulting in a slow, low-temperature burning, and oxidation was suppressed for best metal preservation. He used a movable furnace with unlined conical shell, superimposing it over the pile of wire scrap which was burned *in situ*. He arranged for after-burner treatment of the effluent gases and gas-entrained materials, the afterburner being integral with the furnace shell and directly above the encased scrap pile.*

The U. S. Patent Office found Spitz's method, as distinguished from the apparatus, patentable.

From a time long prior to Spitz's invention, petitioner had been a major reclaimer of copper from scrap. It had made use of open-field burning, and had made use of a stationary refractory-lined furnace. Neither was satisfactory. Upon seeing Spitz's process being practiced by respondent's first licensee, petitioner became intent upon finding some way to obtain corresponding benefits for itself in the recovery of copper. It tried, without success, to have some competing system developed. It also called on an attorney to estimate whether or not a patent should be obtainable on Spitz's furnace (the unit itself) based on petitioner's sketch of its external appearance. The attorney's response expressed doubt that a patent would be granted on the unit, or would be valid if granted. Even assuming that petitioner may have gleaned some knowledge of Spitz's process from observation or otherwise, petitioner did not

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* As the Court of Appeals observed, Spitz

". . . finally developed a concept converse to that previously employed, namely, the burning of the insulation in a portable furnace at a low temperature to be controlled by limiting the availability of air. Spitz's development had several advantages over the prior procedures: it reduced materials handling costs, it diminished air pollution, and it efficiently produced No. 1 grade copper scrap inexpensively by a method which could be operated by relatively untrained personnel."

(Petitioner's app. 17a-18a).

ask for, much less obtain, an estimate (an opinion) as to the prospect of obtaining a valid patent on that process.

The fact that it had obtained a preliminary opinion on the question of apparatus patentability did not deter petitioner from coming to respondent at the beginning of 1960 to obtain a furnace and acquire a license for the practice of respondent's advantageous process. After using that process for a few months with its first furnace, petitioner obtained from respondent another furnace and acquired a license for using that furnace also in Spitz's reclamation process.*

Later, when the Spitz patent issued in February, 1963 with its claims to his process, petitioner then had the opportunity to present a copy of that patent to its lawyer and obtain a meaningful opinion—an opinion on the patent itself. But petitioner did not do so.

About a year later, petitioner deliberately embarked on a campaign to have the movable furnace units copied and to expand its exploitation of the process in violation of respondent's patent rights (petitioner's appendix 2a, 3a, 30a). Petitioner proceeded surreptitiously. When respondent inquired as to whether petitioner would be interested in using further units, petitioner falsely represented that there were reasons why it could not do so, despite the fact that petitioner even then had arranged for the proliferation

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* On page 9 of the petition (and on page 3 by implication), a claim is made, without citation of support, that petitioner developed the process it uses. The speciousness of this claim is apparent from the following two paragraphs quoted from The Final Pretrial Order, stipulated by the parties March 26, 1969, and certified and transmitted to the Court:

> "6. Prior to the purchase of its first incinerator from the plaintiff, the defendant had never invented, obtained, operated or used similar portable insulation burning apparatus or practiced a method of burning insulation with such apparatus.
>
> "7. The plaintiff assisted the defendant in setting up its first portable incinerator and instructed the defendant in the method of removing insulation using the portable incinerator which was furnished pursuant to the license agreement of January 2, 1960. In addition, on behalf of the defendant the plaintiff applied for and obtained appropriate permits from the City of Philadelphia for the erection and use of the incinerator."

of its furnaces and expansion of its use of respondent's patented method by unauthorized copying.*

As the District Court correctly stated, "Patent '421 as issued contains claims 14 through 17 renumbered to be claims 1 through 4. At issue in this litigation are claims 1, 3 and 4." (petitioner's app. 5a; claims 1, 3 and 4 being reproduced at 12a-14a thereof). Pages 8-9 of the petition present misinformation concerning Spitz's application claims 14-17 which, after rejection and amendment, became claims 1-4 of the patent. Petitioner's incorrect version (Pet. p. 9) is that these four application claims, when presented Sept. 8, 1960, all recited superimposing the incinerator unit before igniting the pile, were rejected on that ground, were amended to state those steps in the order set forth in the specification, and were then allowed. This was true as to claims 16 and 17 which became patent claims 3 and 4; it was not true as to claims 14 and 15 which became patent claims 1 and 2 (petitioner's app. 4a, 12a).** On page 11, petitioner sets forth misrepresentations as follows:

> "In the opinion of the Court of Appeals below [App. 29a], the Court acknowledged that respondent's earliest versions of proposed method claims 14-17 attempted to invert the order of steps 1 and 2 of the patented process, . . . The Court states [App. 29a] that respondent **could** recapture the attempted broadened scope of proposed claims 14-17. . . ."

Contrary to these self-serving imputations of petitioner, the Court of Appeals neither specified which claims it was here referring to, nor "acknowledged" what petitioner avers. The

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* Pages 231-233 of the trial transcript.

** On pages 740-741 of the trial transcript, petitioner's expert Levin acknowledged that claim 1 does not call for superimposing the chamber, and that the question of a different recited order of steps from petitioner's steps does not arise.

The history of application claims 14-17, inclusive, is traced in the file wrapper, plaintiff's Exhibit 1-B, through pages 41-48, 50-51, 59-62, 65, 68-71 and 73.

Court's remarks here could only be applicable to claims 16 and 17—not 14 and 15, which never recited a superimposing step. And finally, the Court did **not** state that respondent could "recapture" anything, or say anything about "attempted broadened scope"—this is petitioner's argumentative matter, not something stated by the Court of Appeals. No matter how desperately petitioner needed to relate its alleged file wrapper estoppel argument to claim 1 as well as claims 3 and 4 of the patent, it should have made it clear that in application claim 14 or the resultant patent claim 1, there never was a recitation of superimposing the incinerator, much less a rejection and amendment to change the order of occurrence of superimposing.

The District Court found that the claims of the Spitz patent (if valid) were willfully infringed by petitioner. After giving consideration to petitioner's arguments on its cross appeal with respect to willful infringement, the Court of Appeals for the Third Circuit affirmed that holding.

The District Court, upon considering the aggregate of 12 prior art references (9 patents and 3 articles) relied upon by petitioner, had held the claims of the Spitz patent invalid as obvious under 35 U. S. Code §103. The Court of Appeals gave careful consideration to the prior art and to the District Court's opinion, and reversed, holding the patent valid. The Court of Appeals stated that

> ". . . the essence of the Spitz invention did not lie in the individual steps, but rather, consisted of combining the steps in an unsuggested manner into a process that would achieve a substantially different function and result from the other processes of which the individual stages were a part,"

the invention of the process being patentable even if the individual phases were known in the art (petitioner's app. 25a).

ARGUMENT.

F. THERE IS NO MERIT IN ANY OF THE REASONS URGED BY PETITIONER FOR GRANTING THE WRIT.

Petitioner has advanced five reasons in support of its petition for a writ of *certiorari*. As will be demonstrated, each of these alleged reasons is without merit, and hence the petition for *certiorari* should be denied.

This case presents nothing more than the application of well settled principles to a dispute between the parties as to whether plaintiff-respondent is entitled to relief for willful infringement of its patent.

1. Re Petitioner's Point 1, There is No Split of Authority as to Any Question Determinative of the Infringement Issue in the Present Case.

Despite petitioner's efforts to create the opposite impression, no unresolved question of patent law is here presented for determination. Petitioner on pages 11-17 tries to paint a picture of opposite views "among the various circuits as to whether a patentee may assert against an infringer a broadened interpretation of patent claims which have been **narrowed** in response [to] a rejection by the Patent Office on grounds other than prior art." (From petitioner's heading on page 11, emphasis added.)

There are three reasons why the affirmed holding of infringement in the case *sub judice* is not dependent on law as to which there is divergence among the various circuits. These three reasons are:

(a) One of the three patent claims in suit (claim 1) is literally infringed by petitioner's practice of the wire rec-

lamation process. Hence, even if there were a file wrapper estoppel which could circumscribe the doctrine of equivalents with respect to claims 3 and 4, that would be no basis for a holding of non-infringement of the Spitz patent.

(b) Petitioner's above-quoted proposition cannot even be applicable to claims 3 and 4, since they were not broad claims, narrowed down during prosecution, but rather they originated as **specific** claims which were deemed not to meet the specific conformance requirements of Patent Office Rule 75(d).

(c) From a scrutiny of the law of the six circuits selected by petitioner, including the cases petitioner cites as suggesting the broadest applications of file wrapper estoppel, it does not appear that any of those Courts would reach a result different from the affirmed holding of infringement upon the present facts.

As to the first-enumerated reason, petitioner failed to point out that since claim 1 is literally infringed, it does not even involve the doctrine of equivalents, much less the question whether that doctrine is circumscribed by a file wrapper estoppel. *Graver Tank & Mfg. Co. Inc. et al. v. Linde Air Products Co.* (on rehearing), 339 U. S. 605, 607 (1950); *Williams Bit & Tool Co. v. Christensen Diamond Products Co.*, 399 F. 2d 628, 634 (5th Cir. 1968); *Kolene Corp. v. Motor City Metal Treating, Inc.*, 440 F. 2d 77, 82 (6th Cir. 1971), cert. denied 404 U. S. 886 (1971). Petitioner's expert Levin admitted that the "step of superimposing the chamber on the wire is not in claim 1 specifically", and agreed that claim 1 does not call for the process steps being in different order from the way petitioner uses the process.* He had no alternative but to agree, since the limiting of the air admission rate always is in the claimed order, being estab-

* Pages 740-741 of the trial transcript (supra, p. 5).

lished after the wire pile has been ignited. The unit is lowered the rest of the way to the ground (if used without closable apertures), or the aperture doors are closed to limit the air after igniting.

As pointed out in the counterstatement of the case, the petitioner erroneously proceeds as though all four of application claims 14-17 had recited superimposition of the bottomless enclosing chamber after igniting, and were rejected on that ground and amended. But claims 14 and 15, which after amendment became claims 1 and 2 of the patent, never recited the superimposition, and never required any amendment as to its order (*supra*, p. 5; petitioner's app. 4a, finding of fact No. 19, last sentence).

With respect to the second of the above-enumerated reasons, claims 3 and 4 of the patent never were narrowed down. These claims originated as specific claims Nos. 16 and 17 of the application, first introduced by amendment on September 8, 1960. In these two claims as they were worded when first tendered, the igniting of the scrap pile was recited after the superimposing of the bottomless pile-enclosing chamber. The specification had not mentioned performing the superimposing and lighting in this order, even though it had set forth an alternative construction of the apparatus having apertures provided in the cone, with suitable closure means.*

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*As was brought out at the trial, one can kindle and ignite the pile through such a closable aperture, just as readily as he can kindle and ignite the bottom of the pile while the suspended furnace unit is poised just above, the lowering of the unit the last incremental distance to the ground occurring after ignition. (Pages 208-09 and 278 of the trial transcript.) Petitioner suggests on page 9, contrary to the credible evidence, that until the pile is well ignited, it receives a rush of air and temporary smoking results only if the unit is suspended just above the ground, no such thing occurring if it is already on the ground and the wire pile is lighted through the doors.

Under the Patent Office's Rule 75(d) the Examiner had to reject these two claims which he deemed to be **specific** to a sequence **not expressly described.** Rule 75(d) as it has appeared in each version of the Rules of Practice of the United States Patent Office, from the March 1, 1949 issue to the present date, is as follows:

> "(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."*

This rule prevents the obtaining of a claim to an apparatus or a process which, even if an obvious equivalent of what is shown and described in the specification, is not in every respect in conformity with (i.e., specifically supported by) the specification. *In re Key*, 76 F. 2d 398, 400 (CCPA, 1935); *Bryson v. Clarke*, 92 F. 2d 720, 724-25 (CCPA 1937). In these cases, the Court explained that whereas the doctrine of equivalents is applicable in an infringement case, it does not confer upon an applicant the right to obtain in his patent claims drawn to equivalent versions to those described in his specification.

As the Court of Appeals recognized in rejecting the file wrapper estoppel contention and affirming the trial court's holding of willful infringement of the Spitz patent,

> "Here, the claims were redrafted, not because they trespassed upon the prior art, but because they were considered misdescriptive in view of the specification of the patent. The rejection here was a technical matter based on the Rules of Practice of the Patent Office,

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In fact, in either case, ample air ingress is permitted until the material is well ignited, e.g. by keeping all the doors open for this purpose if the unit is already on the ground (page 44 of the trial transcript).

*** After the Examiner rejected claims 16 and 17 of the application, they were amended to be consistent with the order of steps as described.**

and had nothing to do with the question whether the matter rejected was patentable. In such a situation, it would not be equitable to deprive a patentee of the full fruits of his invention because of a formalistic rule of the Patent Office. See Peterson Filters & Engineering Co. v. Eimco Corp., 155 USPQ 89 (D. Utah, 1967) *aff'd* 406 F. 2d 431, 438 (10th Cir. 1968)."

(Petitioner's app. 29a-30a).

The process flagrantly practiced without license by petitioner not only is literally in accordance with claim 1 of the patent but is the equivalent of the process described and claimed by claims 3 and 4 as well. Defendant's expert Levin acknowledged that a departure from the order of recitation of claimed steps would not avoid infringement of the Spitz patent claims unless the exact sequence of steps is an important part of the patented process.* It is not important whether the igniting precedes the superimposing of the pile enclosing chamber—it is more convenient to light the pile through the apertures (after lowering), if such are provided.**

Therefore, it was proper for the District Court to hold that the claims are infringed, and for the Court of Appeals to affirm that holding.

In *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U. S. 605, 607-08 (1950), this Court made it plain that "the unscrupulous copyist" shall not be permitted to "pirate an invention" merely by relying upon "minor variations to conceal and shelter the piracy." The Court further stated:

> "The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. . . . 'To temper unsparing logic and prevent an infringer from stealing the benefit of the invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same func-

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* Pages 739-40 of the trial transcript.

** Pages 208-09, 278 and 339 of the trial transcript.

tion in substantially the same way to obtain the same result.'" (339 U. S. at 608).

In view of the immateriality whether the pile of wire scrap for reclamation is ignited just before the bottomless chamber has been lowered all the way to the ground, or is lighted just afterward through closeable apertures in the cone, the limitation of admitted air being effected thereafter in either case by lowering the chamber to the ground or by closing the doors, petitioner shows extreme hardihood in its strained efforts to escape the consequence of its piracy of Spitz's meritorious invention on this flimsy ground.

Referring to the aforesaid third reason Contrary to what petitioner implies, there is not a split of authority among the circuits as to a matter on which the correctness of the concurrent holdings of infringement below would depend—not even as to claims 3 and 4 of the patent, as to which the doctrine of equivalents is invoked.

Attention is now turned to the cases petitioner cited from the First, Fourth through Seventh, and Ninth Circuits in its attempt to demonstrate a divergence of opinion tending to aid petitioner [as to claims 3 and 4 to which the doctrine of equivalents applies].* Scrutiny of these and additional cases shows that they do not stand for the proposition which would be of some avail to petitioner as to those two claims. That proposition, inconsistent with the law, is that the presentation, rejection, and cancellation (or amend-

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* Petitioner's seven cases on which it argues a lack of accord with the Third Circuit (inter alia), are:

Borg Warner Corp. v. Paragon Gear Works, Inc., 355 F. 2d 400, (1 Cir. 1966), cert. dismissed 384 U. S. 935 (1966);

Power Curbers v. Etnyre & Co., 298 F. 2d 484 (4th Cir. 1962);

Laitram Corp. v. Deepsouth Packing Corp., 443 F. 2d 928 (5th Cir. 1971);

Parke, Davis and Co. v. American Cyanamid Co., 207 F. 2d 571 (6th Cir. 1953);

Keating v. Stearnes Imperial Co., 347 F. 2d 444 (7th Cir. 1965);

Moon v. Cabot Shops, Inc., 270 F. 2d 539 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960); and

Norwood v. Ehrenreich Photo-Optical Industries, Inc., et al., 322 F. Supp. 898; 168 USPQ 72 (C. D. Cal. 1971).

ment) of claims specific to a process or an embodiment not explicitly described in the patent application and hence ruled out by Patent Office Rule 75(d) will, under a theory akin to the doctrine of file wrapper estoppel, deprive the patentee of the benefit of the doctrine of equivalents for protection against one who, though not literally infringing a patent claim, does the same things in substantially the same way and produces substantially the same result, the principle and mode of operation of the patent being appropriated for the purpose.

In order to avoid over-burdening this brief with analyses of petitioner's cases purportedly not in accord with the law applied in the Third Circuit, those cases, along with a few additional cases for comparison, are discussed in the Appendix hereto.

To summarize the cases on which petitioner purports to rely, in the *Power Curbers* and *Parke, Davis* cases (A2 and A3) the Courts were presented with compelling reasons why there was no equivalence in fact between what was claimed in the narrowed-down claims and the accused products; hence, the claims were not infringed. In the *Borg Warner and Laitram* cases (A1 and A2), the Courts expressed the view that file wrapper estoppel could arise upon claims being narrowed down for various reasons, and yet, while recognizing that the claims there involved had been narrowed by amendment for greater definiteness, the Courts accorded the claims involved in these cited cases a range of equivalents at least as broad as accorded respondent's claims 3 and 4, resulting in the holdings of infringement in the cited cases. The *Moon* case (Ninth Circuit) and the *Norwood* case in the Central District of California (A8 and A9) both involve claims which were narrowed down in view of the prior art (Norwood himself being the prior patentee in the latter case), and hence these two cases, also, do not exemplify any such divergence of holdings as petitioner would imply. The *Keating* case (A4) so clearly involved withdrawing the several original broad claims in favor of limited narrow claims,

along with Keating's own self-contradictions in his specification and his stipulation (347 F. 2d at 448), as to compel the resultant holding and affirmance of non-infringement.

It is clear from these cases that the determination whether the concurrent holdings of infringement in the present case are correct does not depend on resolving a point of law on which the various Circuit Courts of Appeals may be divided. As stated, neither the doctrine of equivalents nor the question of file wrapper estoppel was involved with respect to Spitz's claim 1 which is literally infringed (*supra*, pp. 5 & 9). As to claims 3 and 4, to which the doctrine of equivalents applies, none of the cases cited would stand as a precedent for reaching the opposite result on the issue of infringement upon the present facts. Spitz's claims 3 and 4 started out as **specific** claims (application claims 16 and 17). Since they never were broad, generic claims, they were not narrowed down to avoid prior art or for any other reason. Rather, the Examiner simply required compliance with Patent Office Rule 75(d) which precludes obtaining claims to equivalents (*supra*, pp. 10-11). And since the defendant-petitioner, a deliberate copyist from plaintiff, not only literally infringes claim 1 but practices essentially the same process of metal reclamation to produce the same result in substantially the same way and by substantially the same steps as in claims 3 and 4, it infringes all three asserted claims of the Spitz patent.

2. Re Petitioner's Point 2, The Court of Appeals Applied the Established Law to the Facts Bearing on Validity as Shown by the Evidence.

On pages 17 and 18, petitioner argues that in holding the Spitz patent valid, the Court of Appeals overlooked proof of a prior use of low-temperature burning of insulation by American Smelting Company, and erred in not deeming the "clear and convincing" standard of proof for over-

coming the presumption of validity (35 U. S. C. 282) to have been nullified by this Court's decision in *Graham v. John Deere Co.*, 383 U. S. 1 (1966). For these contentions, petitioner takes liberties with the facts and the law. As to the facts, petitioner states on page 18,

> "Although the Court erroneously indicated [App. 24a] that the prior art did not show low-temperature burning of the insulation from wire scrap, it did not even mention, let alone consider, the scrap copper wire reclamation procedures of the American Smelting and Refining Co. mentioned in the trial court's Findings of Fact [App. 2a]. This finding acknowledges that there was, before the present invention, a commercial wire reclamation process including a second-stage afterburner chamber for burning insulation off of wire. **The trial record clearly revealed that the primary combustion chamber was a low-temperature burning chamber since the amount of air to it was limited.**" (Emphasis added.)

Directly to the contrary, the trial record revealed that American Smelting's primary combustion chambers (twin chambers, for alternate loading) operated at **intense heat**, as follows:

> . . ."They were refractory lined and in my opinion while they burnt the wire they were completely unsatisfactory.
>
> "The operator had to load them with a fork truck and the material had to be placed in a stainless steel sort of a basket or pallet. **The refractory stayed red hot and as soon as the fork-truck operator got within range of the thing, the copper, the insulation, started to burn. He had to quickly put it in, put it down and get out before the whole thing caught fire.**
>
> "Then they had to leave it in perhaps an hour, an hour and a half, or some time, I don't remember ex-

actly; then come and get it, **at which time the refractories were almost white hot. . . ."*** (Emphasis added.)

Concerning the law, petitioner has not cited any case in which this Court (or any other court) has declared at an end the law that the presumption of validity of a patent can be overcome only by clear and convincing proof. The standard of proof has not changed. *Coffin v. Ogden*, 18 Wall. 120, 124 (1874); *Cantrell v. Wallick*, 117 U. S. 689, 696 (1886); *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co.*, 143 U. S. 275, 284-85 (1892); *Adamson v. Gilliland*, 242 U. S. 350, 353 (1916); *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 8 (1934); *Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171 (1937); *Moon v. Cabot Shops, Inc.*, 270 F. 2d 539, 540 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960); *Schmidinger v. Welsh*, 383 F. 2d 455, 462 (3rd Cir. 1967), cert. denied 390 U. S. 946 (1968); *Eimco Corporation v. Peterson Filters & Engineering Co.*, 406 F. 2d 431, 434 (10th Cir. 1968 & 1969), cert. denied 395 U. S. 963 (1969).

Petitioner attempts in vain to read into this Court's opinion in *Graham v. John Deere Co.*, 383 U. S. 1 (1966), an implication that a different standard of proof will henceforth apply. That attempt is defeated by the Court's own words. At page 17, the Court explained,

> "We believe that this legislative history, as well as other sources, shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with Congressional directions that inquiries into the obviousness of the sub-

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* Pages 200-201 of the trial transcript. On pages 297-98 of the trial transcript, Spitz, under cross-examination, accepted a characterization of the air intake to the furnace at American Smelting Company as "somewhat limited". This does not detract from or contradict his testimony quoted above.

ject matter sought to be patented are a prerequisite to patentability."

And further, at page 19, the Court stated,

"Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of Section 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. . . . The standard has remained invariable in this court. . . ."

Since petitioner cannot succeed in reading into the *Graham* decision a change of the legal standard (which the Court explicitly ruled out), petitioner is relegated to urging this Court on page 18 "to make a fresh inquiry as to the vitality and application of" the pertinent rules and decisions. But the obvious motivation for urging the Court to review this case is petitioner's grim determination to escape the consequences of its deliberate, determined piracy of respondent's meritorious invention.

The presumption of validity of a patent is especially strong where, as in the present case, any prior art relied on by an accused infringer is merely cumulative with prior art cited by the Examiner. *Power Curbers, Inc. v. E. D. Etnyre & Co.*, 298 F. 2d 484, 493 (4th Cir. 1962); *Otto v. Koppers Co.*, 246 F. 2d 789, 801 (4th Cir. 1957), cert. denied 355 U. S. 939 (1958). Five of the nine patents relied on by petitioner had been cited by the Examiner in the Patent Office. The District Court observed in its opinion that the four additional patents relied on by petitioner added nothing to the previously cited patents (petitioner's app. 8a). That Court made no explicit holding as to whether or not the three additional publications relied on by petitioner were also merely cumulative. The Court of Appeals, however, stated in its opinion,

"A careful reading of the patents and literature reference cited by Goldstein indicates that they are merely cumulative to the references before the examiner. As such, they add no new material from which

> the district court could conclude that had the examiner read them, he would have held that the invention was unpatentable for obviousness. None of the references cited by the district court, individually or taken as a whole, indicate that organic insulation can be burned in a commercially feasible manner from scrap wire at low temperature without oxidizing or melting the wire."
>
> (Petitioner's App. 24a).

Thus, contrary to the second point in petitioner's argument, the Court of Appeals was cognizant of the facts, and it correctly applied the established law.

3. Re Petitioner's Point 3. The Court of Appeals Applied the Proper Test for Patentability of a Combination of Process Steps.

On pages 19-20, petitioner presents its third argument in support of its petition, i.e., that the Court of Appeals for the Third Circuit did not understand how to apply the law to a claimed process comprising a combination of steps. Here, petitioner has the hardihood to rely again on misstating the facts as to the American Smelting Company's reclamation procedure, characterizing that company's wire-burning chamber as a "low temperature" chamber, and asserting, in the face of the record to the contrary, "The only difference in the process is that the patentee brings his incinerator to the scrap rather than vice versa." Even the initial premise is fallacious (*supra*, pp. 15-16). The interior temperature of American Smelting's refractory chamber was so great that the new charge of wire was catching fire even as the fork-lift truck operator brought it to the proximity of the open 6-foot by 6-foot door. And later, as the operator was extracting the charge of wire by the use of his fork-truck, after about an hour of intense burning, the refractory lining was almost white hot (*supra*,

p. 16). In addition, even if its temperature could have been drastically reduced, that American Smelting structure could not have been superimposed upon piles of scrap. Spitz's process consisting of his new combination of steps not only provided a great improvement in production economy (petitioner's app. 17a and 25a), but also, it accomplished maximum yield of high-grade copper in contrast to the copper loss with the prior processes. Petitioner gave it "the tribute of its imitation" (*Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 438, 31 S. Ct. 444, 450 (1910); *Ackermans v. General Motors Corp.*, 202 F. 2d 642, 645 (4th Cir. 1943), cert. denied 345 U. S. 996 (1953)), and moreover, petitioner publicly boasted of the greater metal conservation realized with this process, pointing out that this justified the selection of petitioner over other scrap reclaimers by concerns with available scrap wire who would be seeking maximum return from their supply. Plaintiff's exhibits 33, 34 and 35 are examples of petitioner's prominent advertisements extolling the advantages of this system. For instance, in plaintiff's exhibit 35, a box advertisement in the issue of American Metal Market of August 9, 1965, petitioner boasts, in reference to this process:

IT'S NOT EASY
TO BURN INSULATED
COPPER WIRE

But We Do It With
Thermo-Controlled Furnaces
And Recover EVERY POUND Of Copper.

And in plaintiff's exhibit 33, in a large two-page center-fold spread advertisement of the special March 19, 1965 issue of American Metal Market, alongside a 10-inch by 13-inch photo of the funnel-shaped furnaces being used at petitioner's main plant for practicing the Spitz process, petitioner further praised the system as follows:

Missiles?

Not at all! They're furnaces which burn off all the insulation from your wire and you end up with 100%

> of the copper content which went in. That's really great when you consider that it's your money we're not burning up!*

Petitioner's recognition of the outstanding performance provided by Spitz's process is shown by its own actions, e.g., by its rejection of its attempted substitute processes, by its advertisements (as exemplified above), and by its recommendation of the process to its European counterpart (*infra*, p. 23). The opinion of the Court of Appeals shows its correct understanding that this outstanding benefit results from the process as a whole (petitioner's app. 24a-25a), a process converse to the prior art (petitioner's app. 17a). The evidence in this case does not show this converse process to have been obvious to persons of ordinary skill in the art; to the contrary, it supports the Court's holding of patentability.

4. Re Petitioner's Point 4. The Charges of Omission and Misrepresentation Are Groundless, and There has been No Error In Dismissing Those Charges.

On pages 20-21, petitioner fails to make it clear that it was never held that petitioner had sustained its burden of proof during the trial of the criticisms which it **alleged** before the District Court and realleged before the Court of Appeals. Neither Court held that the evidence supported petitioner's allegations of omission and misrepresentation. Petitioner tenders its appendix page 26a as support for its charges. But this excerpt from the Opinion of the Court of Appeals does not speak in terms of what the evidence establishes, or even tends to show; rather, it deals with what pe-

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* Plaintiff's Exhibits 33, 34 and 35 and related pages 52-55 of the trial transcript.

titioner **"contends"**, and petitioner's **"allegations** of omissions and misrepresentations" (emphasis added).

These flailing charges had no such merit as to deserve any findings or discussion by the District Court, and they received none. The Court of Appeals dismissed these flimsy allegations in view of their failure to go to matters determinative of the issues, stating, ". . . we hold that, on the facts of this case, such were not material, . . ." (petitioner's app. 26a). The Court of Appeals did not stop there, but went further, holding, on the basis of "a review of the record as a whole", that petitioner did not sustain its burden of proof that the specification fails to teach a person skilled in the art how to operate the process (petitioner's app. 27a).

5. Re Petitioner's Point 5, the Holding of Willful Infringement is Not Error.

Petitioner seems unable [or perhaps unwilling] to present for this Court's consideration a fair and accurate version of the holdings below. The final instance is petitioner's statement on pages 21-22 that the Court of Appeals "supported the finding by the district court of willful infringement by alluding to the fact that petitioner sent blueprints of the respondent's incinerator abroad." What the Court **did** say was:

> "Goldstein next asserts that even if it were held to be an infringer, such infringement was not willful because it sought the advice of patent counsel as to the patentability of Spitz's invention. However, the **opinion of counsel was not sought after the patent issued,** even though more than a year elapsed after issuance before Goldstein began to infringe. **This alone is enough to support a conclusion of willfulness.** Maxon Premix Burner Co. v. Mid-Continent Metal Prods. Co., 270 [sic; 279] F. Supp. 164 (N. D. Ill., 1967), and **when viewed in conjunction with the totality of Goldstein's**

> **actions,** including sending blueprints and operating instructions to a foreign company, we cannot say that the trial court's conclusion in this regard was erroneous."* (petitioner's app. 30a, emphasis added.)

What petitioner understandably is reluctant to discuss is the "totality of Goldstein's actions" which reinforce the affirmed holding of willful infringement. Among petitioner's actions undoubtedly included in the "totality" taken into consideration by the Court are the following:

> (1) Petitioner, having tried with the aid of others to find some way to gain benefits comparable with those of Spitz's development, resigned itself by late 1959 to the fact that it must have the use of the Spitz development. (petitioner's app. 2a-3a).
>
> (2) In late 1959, petitioner obtained an attorney's prediction of unlikely patentability of Spitz's furnace unit. Notwithstanding that prediction, petitioner went ahead in early 1960 with acquisition of a first furnace, and a license from respondent to operate that furnace, and after trying out the process, it acquired a second furnace and license (petitioner's app. 3a).
>
> (3) After the Spitz patent on the wire reclamation method issued February 5, 1963, petitioner did not seek an opinion of counsel as to the validity of that process patent. (petitioner's app. 3a).
>
> (4) From October 1964 on, petitioner deliberately proceeded in its campaign to duplicate Spitz's process, by having the furnaces for which it was licensed copied, and greatly expanding its use of the process in violation

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* Petitioner argues on page 22 that this is the first case "in which a court has required **two** opinions from counsel to a layman" in assessing the willfulness of his infringement. This is not what the Court said. Regardless of whether petitioner obtained a pre-patent prediction as to prospective patentability of a furnace which it sketched in plaintiff's exhibit P108 (the opinion on which petitioner chose not to rely), its defiance of the issued patent on the reclamation **process** without even obtaining an opinion of counsel on that patent was what was significant.

of respondent's Spitz patent (Paragraphs 14 and 15 of the Final Pre-trial Order).

(5) Petitioner falsely represented to respondent that it would not be in a position to expand its use of the patented process, even while it was surreptitiously and unlawfully doing so; and when its ruse was uncovered, petitioner invited Mr. Spitz to go jump in the lake, or "words to that effect" (pages 231-233 of the trial transcript).

(6) Petitioner acquired AMA Metal Corporation of Oceanside, New York on February 1, 1965, at which time that company was already a licensee of respondent with one furnace in authorized use. Within the next month, petitioner proceeded to expand the facilities at that company, and bring about expanded use of Spitz's process in violation of respondent's rights. (petitioner's app. 3a).

(7) In its advertising, petitioner prominently played up the superiority of the process, without crediting Spitz with its development or giving recognition in any way to respondent's Spitz patent. Petitioner also brought about the duplication of the process by a company in Belgium, on the basis of petitioner's instructions, without disclosing the fact that the process had been originated by Spitz—not by petitioner (*supra*, pp. 19-20).

(8) In the course of his testimony under oath during the trial, petitioner's president, Irving Schorsch, persistently evaded forthright acknowledgment of the extent of his company's proliferation of furnaces for the Spitz patented process, evoking the following warning:

"The Court: Mr. Schorsch, I remind you that you are under oath and this is a serious matter.

"The Witness: I understand that, sir.

"The Court: I am suggesting that you carefully consider some of these answers you have been giving, which impress me as being utterly incredible." (page

142 of the trial transcript; see also pages 231-33 of the transcript).

Considering the "totality of Goldstein's actions", including the above-mentioned items, *inter alia*, it is hardly surprising that the Court of Appeals affirmed the District Court's holding that the infringement was willful, even without having the lower Court's benefit of observing the demeanor at the trial of petitioner's executives and witnesses called on its behalf.

Closing its argument against the affirmed holding of willful infringement (page 23), petitioner urges that absence of "**literally** infringed" claims should have ruled out the holding of willfulness (petitioner's emphasis). Even that argument is groundless, since there is not only substantial following of claims 3 and 4 but literal infringement of claim 1 (*supra*, pp. 5 & 9).

CONCLUSION.

Petitioner has strained to reshape the facts and the law and thereby gain a yet further appellate review of a straightforward patent infringement case, as here demonstrated. For the above reasons, the petition should be denied.

Respectfully submitted,

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APPENDIX.

The Cases Relied On For Petitioner's Non-Accord Argument.

Borg Warner Corp. v. Paragon Gear Works, Inc., 355 F. 2d 400 (1st Cir. 1966), cert. dismissed 384 U. S. 935 (1966), is the first of petitioner's alleged non-accord cases (Pet. p. 13). The Court there expressed its view that file wrapper estoppel could be based upon an applicant acceding to a demand to cancel claims for reasons other than prior art. Nevertheless, the Court did accord the patentee the benefit of the doctrine of equivalents with respect to the very matter upon which the patentee, during the prosecution of the application for the patent, had introduced quantitative limitations in his claims to yield to the Examiner's rejection on indefiniteness.* From the decision, it is clear that but for so according the patentee the benefit of the doctrine of equivalents as to the angle recitations added to the claims by amendment, his claims would not have been held infringed.**

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* This matter, introduced into the claims in response to the Examiner's position, was the recitation of angles in degrees between ports of a reversible pump, and recitation of the angle of rotation of the reversing plate.

** In the cited **Borg Warner** case, the Court of Appeals for the First Circuit considered the question whether there is a conflict, as to the applications of the doctrine of file wrapper estoppel, between cases decided by the Courts of Appeals of certain circuits as exemplified by **McCullough Tool Co. v. Well Surveys, Inc.**, 342 F. 2d 381 (10th Cir. 1965), and cases decided by certain other circuits as exemplified by **Parke, Davis & Co. v. American Cyanamid Co.**, 207 F. 2d 571 (6th Cir. 1953). These are two of the cases on which petitioner relies on pages 12 and 14 of its petition, respectively, as supporting its contention that the law is unresolved. But the Court of Appeals for the First Circuit did not find any sharp inconsistency between the laws of the different circuits. It found instead that the differences are "linguistic"—they relate more to the mode of expression than to the substance. (355 F. 2d at 405-06). A review of the cases dealt with herein, including petitioner's alleged non-accord cases,

Petitioner's next case (Pet. pp. 13-14) is *Power Curbers v. Etnyre & Co.*, 298 F. 2d 484 (4th Cir. 1962). The plaintiff's patentee Canfield originally applied for patent coverage for curb-forming machines moving on either wheels or skids. His claims as presented were to cover both arrangements. But the Examiner took the position that Canfield's disclosed machine version relying on skids would be inoperative. This position was "enthusiastically accepted, adopted and supported by the applicant, . . .", who then narrowed his claims to call for reliance upon wheels only (298 F. 2d at 495). The resulting claims narrowed to wheel coverage were held not infringed by an Etnyre curb machine using rear skids—a machine showing that the defendant Etnyre had found out how to do what the patentee Canfield had acknowledged he could not do. The doctrine of equivalents could not apply to that case, since the nonequivalence of Etnyre's machine using skids was conclusively established.

Petitioner's next case (Pet. p. 14) is *Laitram Corp. v. Deepsouth Packing Corp.*, 443 F. 2d 928 (5th Cir. 1971).* With respect to the plaintiff's shrimp slitting machine patent 2,694,218, the District Court had held that claims 1 and 3, while not literally infringed by the defendant's accused shrimp processing machine, normally would embrace that machine under the doctrine of equivalents. However, the District Court concluded that the doctrine of equivalents was unavailing to the patentee with respect to claim 1 (the first of these two claims) because of file wrapper estoppel arising from limitations inserted by

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likewise leads to the conclusion that there is little if any inconsistency between the principles applied in the different cases, the distinctions being primarily distinctions of fact (e.g., whether or not equivalence in fact is present), rather than distinctions in underlying legal principle.

* As a result of this litigation and a related case dealing with the question whether the exporting of machine parts for assembly by customers abroad into shrimp processing machines infringes a U. S. patent, the Supreme Court granted certiorari limited to that question (92 S. Ct. 702 (1972)), and held that such acts do not infringe.

amendment. Before the Court of Appeals, Deepsouth contended that the trial court had erred in failing to hold that file wrapper estoppel similarly barred claim 3 of the '218 patent from being infringed under the doctrine of equivalents (443 F. 2d at 931-32). The Court of Appeals reached the opposite conclusion—that claim 1 as well as claim 3 should have been held infringed under the doctrine of equivalents, notwithstanding the alleged file wrapper estoppel (443 F. 2d at 934-35).

Petitioner's next case (Pet., pp. 14-15) is *Parke, Davis and Co. v. American Cyanamid Co.*, 207 F. 2d 571 (6th Cir. 1953). The District Court granted defendant Cyanamid's motion for summary judgment, holding that its medicinal product did not infringe plaintiff's patent No. 2,407,096 for anti-anemia vitamin products. The Court of Appeals affirmed, noting that after plaintiff's claims in their broader form had been rejected, it had introduced more limiting language in its claims as to how, and from what, the product was derived, thereby obtaining the allowance of the claims. The Court held that the plaintiff was thereby estopped to deny the limiting effect of the narrowed claims, this limiting effect being qualified thus:

> "The claims of the patent in suit are expressly limited to a product derived by autolysis [**or equivalent procedure**] of mammalian liver [**or similar materials**] by reason of the following claim language:
>
> 'said acid being the acid derived by autolysis of mammalian liver tissue and being free from pantothenic acid and the antipernicious anemia principle obtainable from said liver tissue, * * *.'"
>
> (207 F. 2d at 572; emphasis added).

In line with the emphasized qualifying phrases in the above-quoted passage, the reason why the accused American Cyanamid product did not infringe was not mere failure to come within the literal words of the claims, but rather, the **non-equivalence** as to the material and the procedure between that product and what was claimed by the claims

as narrowed and allowed, the Court observing, at page 573,

> "It is admitted that appellees' product is not derived from mammalian liver tissue nor from **any** animal product. It is obtained by **synthesis from discrete chemical compounds of known chemical structure by a method unrelated to the method described and originally claimed in the patent."***
>
> (Emphasis added)

The fact of the non-equivalence to what was claimed made the doctrine of equivalents inapplicable whether or not there was file wrapper estoppel.**

Petitioner's next case (Pet. p. 15) is *Keating v. Stearnes Imperial Co.*, 347 F. 2d 444 (7th Cir. 1965). Keating obtained a patent on a fast-heating oven. The oven he described was enclosed in a housing and arranged for continuous-chamber heating of its side, top and bottom walls and its rear wall (five directly heated walls). Defendant's accused product had no heating of its rear wall—it relied only on heating the sides, top and bottom, as the plaintiff-patentee Keating

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* The defendant's product was made with different materials, using defendant's independently discovered, entirely different process on which defendant was granted its own patents (207 F. 2d at 572-73).

** In **Kolene Corp. v. Motor City Treating, Inc.**, 440 F. 2d 77, 83 (6th Cir. 1971), cert. denied 404 U. S. 886 (1971), the patent in suit claimed a nitriding process using an aerated bath comprising "between about 25 and 40% cyanate," a limitation which had been added to the claim by amendment. The defendant Motor City, which used 46 to 50% cyanate in its bath for the nitriding process, was held to infringe. The specified limits (25-40%) of the cyanate percentage range had not been relied on for patentability of the claim over the prior art, since the prior art lacked **aeration** of its cyanate bath (a 15% cyanate bath). In affirming the holding of infringement, the Sixth Circuit Court of Appeals held (1) that Motor City's process with its 46 to 50% cyanate literally infringed, and (2) that in any event, the doctrine of equivalents was available to the plaintiff Kolene, unimpaired by the file wrapper estoppel on which the defendant attempted to escape liability. This case is consistent with the Court's holding in the **Parke, Davis** case, the opposite holdings resulting from the absence of equivalence in fact in the **Parke, Davis** case and the presence of equivalence in fact in the **Kolene** case.

stipulated (347 F. 2d at 448). Keating's original application claims had been broad enough to cover generically such a four-wall heating arrangement, but had been rejected and cancelled.* As the Court observed:

> "Plaintiff's original Claim No. 1, as revealed by the file wrapper, described an oven without a continuous heating chamber. Plaintiff's original Claims Nos. 2, 3, 5, 6 and 7 described a continuous heating chamber surrounding 'at least a portion of said closed oven chamber'. Original Claims Nos. 8 and 9 referred to a 'method' of producing baked products using turbulent air. All of these claims were rejected by the Patent Office and cancelled. The claim which was allowed requires the continuous heating chamber to surround the oven chamber on five sides. Claims which might have been construed to cover less extensive heating chambers (such as the one in defendant's product) were denied."

Accordingly, the Court affirmed the District Court's holding that the resulting narrower claims were not infringed by the accused product with its four heated walls.

Ellipse Corp. v. Ford Motor Co., 452 F. 2d 163, 168 (7th Cir. 1971), cert. denied 92 S. Ct. 2041 (1972), is not inconsistent in principle with the above-discussed Seventh Circuit cases, *Keating v. Stearnes* and the *Unilectric* case. In

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* Petitioner states that "The patentee . . . had **voluntarily** restricted his claims to narrower language." It is clear that he retrenched from his original **breadth** of claiming to **narrower** claims (unlike Spitz in the present case), but it is not clear that he did so voluntarily (i.e., independently of the Examiner's holding that the broad claims could not be allowed). A case in the Seventh Circuit which did involve the question of file wrapper estoppel based on a **voluntary** withdrawal of a broader claim is **Unilectric, Inc. v. Holwin Corp.**, 243 F. 2d 393, 398 (7th Cir. 1957), cert. denied 355 U. S. 830 (1957). There the Court rejected the file wrapper estoppel contention and affirmed the trial court's conclusion that claim 3 of the patent was infringed by the refrigerator light socket manufactured by the declaratory judgment plaintiff, by virtue of the doctrine of equivalents (243 F. 2d at 397-98). The fact that claim 4, which "for all that appears was cancelled voluntarily", was more general in character was held not to estop the patentee "from claiming its right to a reasonable range of equivalents under Claim 3." (243 F. 2d at 398).

the *Ellipse* case, claim 3 of Ellipse's Rhine patent was held infringed by a balanced slipper pump used in Ford's power steering. The pump shown and described in the patent was a balanced (symmetrical) slipper pump with an elliptical stator cavity. During the prosecution of the application the phrasing in claim 3 that the stator cavity is "elliptical" was amended to "out-of-round", which the trial court and the Court of Appeals understood in the context to mean "elliptical or equivalent." Ford unsuccessfully contended that notwithstanding Rhine's pump being shown and described with an elliptical stator cavity (which undeniably is out-of-round), the adoption of the finally chosen term "out-of-round" compelled claim 3 not to be construed in the light of Rhine's specification as meaning elliptical **or equivalent,** but rather to be construed so broadly as to encompass unbalanced slipper pumps of the prior art with their quite different stator cavity configurations. This proposition was advanced by the defendant in that case as a "file wrapper estoppel" on which to predicate its contention of invalidity. After reviewing cases on file wrapper estoppel, the Court of Appeals stated,

> "There is no file wrapper estoppel where the change in the wording was **to clarify that the stator cavity** of the Rhine pump **could merely be something more than a mathematically perfect ellipse.**
>
> "In the file wrapper Rhine refers to the limitation in the original claim that the stator be 'elliptical' as being only **'somewhat broadened'** by the added term 'out-of-round'. That reservation when considered in light of Rhine's apparent purpose in substituting 'out-of-round' sufficiently qualifies the scope of other comments in the file wrapper and limits the scope of 'out-of-round' to an 'elliptical or equivalent' stator cavity, as found by the district court. The failure to strike 'elliptical' from the specifications is one more indication that the applicant intended that term or its equivalent to define the shape of the cavity. The district court did not err in construing the scope of the amendment

to be an 'elliptical or equivalent' stator cavity."
(452 F. 2d at 168, emphasis added).

In *Bishman Mfg. Co. v. Stewart-Warner Corp.*, 380 F. 2d 336, 339-340 (7th Cir. 1967), cert. denied 389 U. S. 897 (1967) (pet., p. 11), the Court of Appeals for the Seventh Circuit stated that a necessary condition for the establishment of a file wrapper estoppel is that the patentee must have narrowed his claim in response to an objection by the Patent Office. That case involved a Hemmeter patent on an automobile wheel balancer having a fixed counterweight attached to the hub and a pair of counterweights which rotate indefinitely in opposite directions relative to the hub. The District Court's holding that claim 4 of the Hemmeter patent was valid and infringed by Stewart-Warner was affirmed. By amendments, Hemmeter's claims had been restricted to require that the counterweights be journalled to the hub in such a manner as to rotate in axially spaced planes of rotation. The Court's holding of infringement depended on the benefit of the doctrine of equivalents being accorded to Hemmeter's claim in suit since the defendant's counterweights were not journalled as stated in the claim but were **radially** spaced for rotation in the **same** plane. The Court rejected the defendant's file wrapper estoppel contention, stating:

"Furthermore, in view of these numerous recitations from the cancelled claims, it is apparent that by finally adopting the 'axially-spaced planes of rotation' language (through the amendments drafted by the defendant's patent counsel) the patentee was simply adhering to the most descriptive recitation of his structure and was not 'abandoning' part of his claim to obtain a patent. The doctrine of file wrapper estoppel is therefore inapplicable."

(380 F. 2d at 340).

Petitioner, in discussing the *Bishman* case on page 11 of its petition, fails to mention the result reached, much less bring out the fact that that result (the holding of infringement

by virtue of the doctrine of equivalents) is converse to the same Court's earlier result in *Keating v. Stearnes Imperial Co.*, 347 F. 2d 444 (*supra*, A4). The real difference is that upon considering the facts of the cases, in *Keating v. Stearnes* there was not equivalence in fact between the accused product and what was claimed in the patent as issued; in contrast, in the *Bishman* case, there was equivalence in fact between the accused product and the claim, despite the limitation inserted by amendment which prevented its literal applicability to the product. Petitioner, on page 11, diverts attention from the result reached in the *Bishman* case to *Powder Power Tool Corp. v. Powder Actuated Tool Co.*, 230 F. 2d 409 (7th Cir. 1956), wherein the Court held the patent in suit invalid and non-infringed. Petitioner argues that *Bishman* did not overrule or attempt to distinguish that earlier case. The *Bishman* case had no need to refer to that earlier case since the Court had there taken into account the whole history of prosecution of Powder Power's patent and concluded that its claim limitations which could not be met by the accused devices were indispensable limitations, and therefore had held the claims not infringed (in addition to holding them invalid).

Petitioner's next case (Pet., p. 15) is *Moon v. Cabot Shops, Inc.*, 270 F. 2d 539 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960). The Court affirmed the decision below holding the Moon patent valid but not infringed, on the grounds of the trial court's holding of non-equivalence in fact—a holding which placed no reliance on file wrapper estoppel. The Court of Appeals stated, at page 545:

> "The factual finding of the trial court that the accused devices are not equivalent to the patent claims, as so construed, is not to be disturbed unless clearly erroneous. . . . We find no clear error in the making of this finding."
>
> "Although the doctrine of file wrapper estoppel was argued before the District Court, that court declined to dispose of the case on that ground. In our view it could have done so. The patentee in this case nar-

> **rowed** his claims in order to escape rejection. By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents. . . ."
>
> (Emphasis added)

This *obiter dictum* concerning file wrapper estoppel is consistent with the fact that the claims had been narrowed to the cab-straddling arrangement in view of the prior art. As the Court stated, at page 542,

> ". . . The Examiner rejected Moon's earlier claims on the ground that they were merely reversals of the prior art. When Moon clarified his claims, so that provision was made for the legs to straddle the driver's position, the claims were allowed. It would seem therefore that in the opinion of the Examiner **the straddling of the cab by the derrick legs was the crux of the invention."***
>
> (Emphasis added)

Petitioner's last case for postulating its alleged split of authorities (Pet. pp. 12 & 15) is a District Court case, *Norwood v. Ehrenreich Photo-Optical Industries, Inc., et al.*, 322 F. Supp. 898, 168 USPQ 72 (C. D. Cal., 1971). Norwood had presented, in application for his patent in suit, generic claims broad enough to cover the photographer's light meter shown in that application and the considerably different product of the defendant Ehrenreich. Ehrenreich's light meter employed two lenses and two separate photocells (light responsive units), connected together. The Patent Office rejected Norwood's broad generic claims on the ground that they would cover what Norwood himself had patented back in 1964. This ground of rejection is just as compelling as a rejection on the prior art originating from any **other** inventor. In response, Norwood narrowed his claims to make them specific to use of only a single lens and

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* The accused derrick-truck of defendant-appellee Cabot Shops, Inc. did not have the derrick legs straddling the driver's position, but was differently arranged for the erection of a non-straddling hinged derrick at the front of the truck.

a single light-responsive means. The same narrowing Norwood was required to adopt to avoid having the claims barred by a prior patent (in that case, barred by his own prior patent) equally prevented the claims from being applicable to the accused devices. That is not parallel to the situation presented here.

This *Norwood* case, decided by a District Court in California (actually in the Ninth Circuit), is not inconsistent with the *dictum* in *Moon v. Cabot, supra,* or with the cases decided by the Tenth Circuit Court of Appeals, *Sears Roebuck & Co. v. Jones,* 308 F. 2d 705, 707-08 (10th Cir. 1962), cert. denied 371 U. S. 952 (1963); *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F. 2d 381, 403 (10th Cir. 1965), cert. denied 383 U. S. 933 (1966); *Eimco Corporation v. Peterson Filters & Engineering Co.,* 406 F. 2d 431, 438 (10th Cir. 1968 & 1969), cert. denied 395 U. S. 963 (1969). In the three last-named cases, the claims having not been narrowed because of prior art, the file wrapper estoppel contention was rejected, the Court of Appeals affirming the district court holdings that the patents in suit were infringed by virtue of the doctrine of equivalents.

The above-discussed cases do not show any substantial lack of conformity to this Court's restatement of the law in *Graham v. John Deere Co.,* 383 U. S. 1, 33 (1966), quoted and relied on in *Schmidinger v. Welsh,* 383 F. 2d 455, 465 (3rd Cir. 1967), cert. denied 390 U. S. 946 (1968), that:

> "Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent."

While some courts have on occasion expressed the view that file wrapper estoppel could arise in yet other cases of claims having been narrowed, upon scrutiny, most if not all cases

in which such views have been expressed actually turned on such compelling factors as the presence or absence of equivalence in fact.*

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*The dependence on the **facts** of equivalence or non-equivalence is demonstrable from the above discussed examples in the Sixth Circuit cases (claims in suit being held infringed under the doctrine of equivalents in the **Kolene Corp.** case, but not in the **Parke, Davis and Co.** case), and in the Seventh Circuit cases (claims in suit being held infringed under the doctrine of equivalents in the **Unilectric, Inc.** case and the **Bishman** case, but not in the **Keating** case or the **Powder Power Tool Corp.** case).